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10/596,200

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20999 7590 09/04/2009  
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EXAMINER

LEA, CHRISTOPHER RAYMOND

ART UNIT

PAPER NUMBER

1619

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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|--|---|--|--|
| <p align="center"><b>Advisory Action</b><br/><b>Before the Filing of an Appeal Brief</b></p> | <p><b>Application No.</b><br/>10/596,200</p>  | <p><b>Applicant(s)</b><br/>KERDAR ET AL.</p> |  |
|  | <p><b>Examiner</b><br/>Christopher R. Lea</p> | <p><b>Art Unit</b><br/>1619</p>              |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 28 August 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: 14.  
Claim(s) rejected: 1-14.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Ernst V Arnold/  
Primary Examiner, Art Unit 1616

Continuation of 3. NOTE: Though as applicant has argued the amendment does correct the objection to claim 14 for lacking antecedent basis, it creates a new objection for informalities (i.e. claim 14 as amended contains an extra "is" which renders the claim grammatically incorrect). Trading one objection for another does not simplify the issues for appeal.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant begins by reasserting the previously presented arguments, and further addresses the counterarguments (1-4) presented by the examiner in the final rejection. As to 1) concerning the overlapping range & 2) conditions required to generate the tear strength, the examiner does not find these convincing. The examiner's ultimate contention is that the prior art and claimed invention contain the same chemical elements arranged in a similar manner to produce similar compositions. The arguments (1 & 2) seem to come down to whether or not the prior art and claimed products have the same properties. The examiner a chemical composition and its properties are inseparable; therefore, if the prior art teaches the identical chemical structure, the properties applicant claims are necessarily present. This presumption is rebuttable; however, applicant has not, to date, provided evidence to rebut it. As to 3) concerning the selection of lidocaine from the long list of active agents, the examiner contends that Rupprecht clearly lists lidocaine as a suitable active agent and Levin provides motivation for selecting it from the list. As to 4) concerning the amounts of active agent taught by Rupprecht being infeasible in the invention, the examiner finds this unconvincing. Applicant's argument appears to be an assertion that Rupprecht is not enabled for all it discloses, and if so, applicant must present factually-supported objective evidence to that effect. Applicant further argues that the examiner has failed to reestablish his prima facie case of obviousness by starting over; however the examiner finds applicant's argument defective. The applicant has cited *In re Rinehart* for support; however, the section of *In re Rinehart* cited clearly states that the examiner "must start over" when "evidence is submitted in rebuttal." The examiner draws applicant's attention to MPEP § 716.01(c) II which states that "[t]he arguments of counsel cannot take the place of evidence in the record." Additionally, looking at *In re Rinehart*, it is clear that the "evidence" cited there was a Rule 132 declaration. To date no evidence to support applicant's arguments or demonstrate a secondary consideration (e.g. unexpected results) has been presented; hence, the examiner cannot consider it and is not required to "start over" as applicant has insisted. To summarize the examiner believes that all of the elements of applicant's invention are disclosed in Rupprecht et al. and Levin, either explicitly (e.g. crosslinked film) or intrinsically (e.g. tear strength), and applicant has provided no factually-supported objective evidence to rebut the prima facie case of obviousness. For these reasons the rejection under 35 U.S.C. § 103(a) is maintained.